Hearing: 9/5/01
July 24, 2001

Paper No. 11
DEB

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re University of Iowa d/b/a University Health Care

Serial No. 75/710,869

Kirk M. Hartung and Wendy K. Marsh of Zarley McKee Thomte Voorhees & Sease for the University of Iowa.

Linda E. Blohm, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Seeherman, Wendel and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

University of Iowa d/b/a University Health Care has applied to register UI HEALTH CARE (HEALTH CARE disclaimed) for the following services, as amended, "educational services, namely, conducting classes, conferences, seminars and workshops in the fields of medicine and nursing," in International Class 41, and "inpatient and outpatient medical services; medical and health care research," in International Class 42.[1]

[1] Application Serial No. 75/710,869, filed May 20, 1999, asserting a *bona fide* intention to use the mark in commerce.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of a registration owned by Upledger Institute for the stylized UI mark as shown below:

for "providing courses of instruction in various modalities to healthcare practitioners," in International Class 41, and for "medical services," in International Class 42.[2]

This appeal has been fully briefed by applicant and by the Trademark Examining Attorney. At applicant's request, an oral hearing was held before this Board.

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors that should be considered in determining likelihood of confusion.

We turn first to a consideration of the services. Registrant and applicant have both recited services in two international classes. In class 41, applicant has recited

[2] Reg. No. 2,130,160 issued on January 20, 1998.

its services as "educational services, namely, conducting classes, conferences, seminars and workshops in the fields of medicine and nursing." The cited registration lists "providing courses of instruction in various modalities to healthcare practitioners." While the recitations employ different wording, these are legally identical educational services directed to medical, nursing and/or other health care professionals. The recitations in class 42 are in part legally identical in that both include "medical services" (applicant's recitation being broader in that it also includes "medical and health care research"). Although applicant argues that the respective services are not identical, it does not attempt to explain the differences. Additionally, we note that there are no limitations in the recitation of services in the application or the registration as to any particular channels of trade or type of purchaser. Accordingly, it must be presumed that the services of both would be offered in the same channels of trade to the same potential purchasers. *See Canadian Imperial Bank of Commerce National Association v. Wells Fargo Bank*, 811 F2d. 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Clearly, if these educational and medical services were to be rendered under the same or similar marks,

confusion as to the source or sponsorship of such services would be likely to occur. As we turn to a comparison of the similarity or dissimilarity of the respective marks at issue herein, we are guided by the well-recognized principle that the degree of similarity necessary to support a conclusion of likelihood of confusion decreases when the marks are being used on virtually identical services. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

In considering the marks herein, applicant argues that the cited UI mark is actually such a highly-stylized logo that it is difficult to be sure which letter or letters it represents. Applicant also claims that the Trademark Examining Attorney has improperly dissected its own composite mark to support a finding of likelihood of confusion. Accordingly, applicant maintains that when the marks are compared in their entireties, the words HEALTH CARE in its mark serve as a distinguishing factor. By contrast, the Trademark Examining Attorney argues that the letters UI are totally arbitrary while the designation HEALTH CARE is generic in this field.

As to the stylization of the cited mark, we conclude that consumers will recognize this as the stylized letters "U" and "I." Further, as noted by the Trademark Examining

Attorney, applicant is seeking registration for the word mark UI HEALTH CARE in a typed format. Applicant's registration of its mark in typed format would give applicant rights to the mark in all normal and reasonable manners of presentation. *See Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233, 1235-36 (TTAB 1992). Although such rights would not extend to the highly stylized form depicted in the registered mark, applicant could certainly use a similar type style for the separate letters "U" and "I."

Additionally, although the term HEALTH CARE at the end of applicant's mark results in that mark being longer by two words than registrant's mark, its presence is not sufficient to distinguish the marks. It is well established that, although marks must be compared in their entireties, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. *In re National Data Corp.*, 753 F.2d 1056, 2224 USPQ 749 (Fed. Cir. 1985). The term HEALTH CARE has, at the very least, a highly descriptive meaning in the context of medical education and health care services. In this connection, we also note that applicant has disclaimed exclusive rights to the designation HEALTH CARE, thus admitting its descriptive

significance. Because of the descriptive significance of HEALTH CARE for applicant's services, it will not be accorded as great a source-identifying weight by consumers as will the arbitrary designation, UI – clearly the dominant element of applicant's mark.

Applicant also makes the argument that inasmuch as the cited registration is owned by Upledger Institute, the UI of the cited mark is "highly suggestive." To the extent applicant is asserting that the cited registration is entitled to a limited scope of protection because UI represents the initials of registrant's trade name, there are two immediate problems with this analysis. First, the term "Upledger Institute" itself appears to be arbitrary for medical education and health care services. Second, even if we had some basis on which to conclude that members of the relevant public viewed the initialism UI as synonymous with Upledger Institute, the initials are still deemed arbitrary for these services.

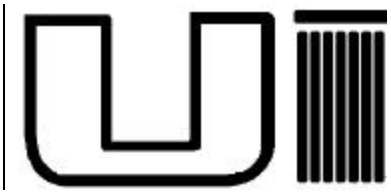
Furthermore, to the extent that applicant is trying to assert that members of the relevant public understand the initialism UI to refer to Upledger Institute, there is no evidence in the record to support this contention. Moreover, if this were the case, consumers would be likely

to make the same connection between the UI in applicant's mark and registrant, Upledger Institute.

As to the *du Pont* factor dealing with the number and nature of similar marks in use on similar goods, applicant argues that the cited mark is weak because there exists a single third-party registration of another stylized UI mark for insurance underwriting.[3] However, while this registration does include underwriting for accident and *health* insurance, use of the same two-letter designation for insurance underwriting services hardly demonstrates that UI is at all weak for medical education and health care services.

Furthermore, this third-party registration is not evidence that the mark shown therein is in commercial use, or that the public is familiar with this mark. *See In re Albert Trostel & Sons Co.* 29 USPQ2d 1783 (TTAB 1993). Thus, this single registration in a different field provides no evidence that the cited registration is entitled to only a limited scope of protection in the relevant field.

[3] Reg. No. 882,647, issued to United Insurance Company of America on December 16, 1969, for "underwriting life, health, and accident insurance," for the stylized UI mark as shown to the right →



In conclusion, the designation UI appears to be totally arbitrary in the present context, and applicant's services are identical to those in the cited registration. Given these circumstances, we find that applicant's mark is sufficiently similar to the registrant's stylized mark that if applicant were to use the applied-for mark in commerce, confusion would be likely.

Finally, we note that if there were any doubt in our minds on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. *See In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); and *Giant Food Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Decision: The refusal to register under Section 2(d) of the Act is affirmed.